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In re Application of: :
HOHNEKER, John, Arthur, et al. :
PCT No.: PCT/EP03/05988 : DECISION ON PETITION
U.S. Application No: 10/517,074 : UNDER 37 CFR 1.47(A)
International Filing Date: 06 June 2003 :
Priority Date: 10 June 2002 :
Attorney's Docket No.: ON/4-32515A :
For: COMBINATIONS COMPRISING :
EPOTHILONES AND PHARMACEUTICAL :
USES THEREOF :
:

This decision is issued in response to the 19 April 2005 submission by applicants of a declaration executed by three of the four inventors, treated herein as a petition under 37 CFR 1.47(a) for acceptance of the application without the signature of the remaining inventor. Deposit Account No. 19-0134 will be charged the required petition fee.

BACKGROUND

On 06 April 2003, applicants filed international application PCT/EP03/05988 which claimed a priority date of 10 June 2002 and which designated the United States. On 18 December 2003, a copy of the international application was communicated to the United States Patent Office ("USPTO") by the International Bureau ("IB"). The deadline for filing the basic national fee was thirty months from the priority date, i.e., 10 December 2004.

On 06 December 2004, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 12 April 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) indicating that an executed oath or declaration and the surcharge for filing the oath or declaration later than thirty months after the priority date were required.

On 19 April 2005, applicants the materials considered herein. The submission included payment of the required surcharge, a declaration executed by three of the four inventors, and a statement regarding the purported refusal of the remaining inventor, John David ROTHERMEL, to execute the declaration.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Pursuant to the previously filed authorization, Deposit Account No. 19-0134 will be charged the required petition fee. Item (1) is satisfied.

The 19 April 2005 submission does not include an express statement of the nonsigning inventor's last known address. Item (2) is therefore not satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Procedure ("MPEP") states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have filed a declaration executed by three of the four inventors and including an unsigned signature box identifying the nonsigning inventor. This declaration is treated as having been executed by the available inventors on their own behalf and on behalf of the nonsigning inventor. Item (3) is therefore satisfied.

Regarding item (4), applicants assert that the nonsigning inventor has refused to execute the application. However, before a refusal to execute the application can be claimed, MPEP § 409.03(d) requires that the nonsigning inventor be provided with a copy of the complete application, including specification, drawings, and claims. The MPEP also requires "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made." Applicants here have supplied a statement from Oona A. Jackson with respect to the inventor's purported refusal to sign the application. However, this statement does not provide specific details regarding the attempts to obtain the inventor's signature and his purported refusal. In addition, it is not clear whether Oona A. Jackson is the proper person to provide this statement in that the statement does not assert that Ms. Jackson is the person who made the attempts to obtain the inventor's signature and to whom the inventor made his statement of refusal. Finally, applicants have not provided the required firsthand evidence confirming that the inventor has been provided with a copy of the complete application papers. Item (4) is not satisfied on the present record.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must be accompanied by the materials needed to satisfy the outstanding requirements for a grantable petition, as discussed above and in the section 409.03 of the MPEP.

No additional petition fee is required.

Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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